

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following comments.

Claims 27-28, 31-32, and 35 are presently amended. Additionally, claims 1, 3-4, 16-17 and 39 are withdrawn from consideration and claims 2, 5-15, 18-26, and 29-30 are canceled. Applicants request that the examiner enter the above claim amendments as no new matter has been added. In particular, exemplary support for the amendments to claim 1 may be found in the specification on page 1, line 34 - page 2, line 8, and page 4, lines 16-20. Upon entry of this response, claims 1, 3, 4, 16, 17, 27, 28, 31-38, and 40-44 are pending.

I. Rejection under 35 USC§101

Claims 27 and 28 are rejected under 35 U.S.C. §101 for allegedly lacking patentable utility. The examiner argues that the claims do not recite the function or achieved result of the claimed computer program. Accordingly, applicants have amended claims 27 and 28 to clarify that the claimed method identifies a framework protein for subsequent modification. Applicants believe that this amendment imparts a “real world” use to claims 27 and 28, *i.e.*, the identification of “a corresponding framework protein for subsequent modification to impart a desired property, characteristic or function to the framework protein.” Therefore, applicants believe that the present claims are “immediately useful” and request that the present rejection be withdrawn.

II. Rejection under 35 USC §112

A. Rejection for non-compliance with the written-description requirement

Claims 27 and 28 are rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written-description requirement. In particular, the examiner argues that “the specification fails to disclose a *computer readable* medium.” Applicants respectfully disagree.

Applicants argue that the MPEP does not require the specification to provide express disclosure for claim amendments in order to satisfy 35 USC §112, first paragraph. Specifically, MPEP § 1302.01 and §2163 I(B) state that “while there is no in haec verba requirement, newly added claim limitations must be supported in the specification through an express, implicit or inherent disclosure.” See also 37 CFR 1.121(e) (requiring only substantial correspondence between the language of the claims and the language of the specification). Case law also supports the idea that the exact terminology from the specification is not necessary to satisfy the written description requirement. See *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (noting that “the exact terms need not be used in haec verba to satisfy the written description requirement of the first paragraph of 35 USC §112”).

Applicants argue that the present specification both implicitly and inherently discloses a computer program containing “a computer-readable medium.” First, as set forth by the examiner, the specification, on page 9, lines 27-28, states that the instant invention “resides in a computer program”. Second, the specification, on page 6, lines 4-16, clearly refers to the use of a computer to run the computer algorithms used to search through the protein database. Third, the specification on pages 15-19 and in Schemes A-D describes how *computer* database searching is performed using the programs developed by the present invention.

Accordingly, applicants believe that the above cited sections of the specification clearly imply that the claimed program is encoded in a “computer readable medium,” because the specification describes the program’s use in searching a computer database of proteins. Clearly, in order for a program to be able to search through a computer’s database, the computer must be able to read the program. Therefore, the searching program must be encoded in a computer readable medium. Accordingly, applicants believe that no new matter has been added by the claim amendments and request that the examiner withdraw this rejection and allow the claims.

B. Rejection for alleged indefiniteness

Claims 28 and 35 stand rejected under Section §112 for allegedly failing to particularly point out and distinctly claim the subject matter of the invention. Applicants respectfully disagree.

As requested by the examiner, claim 28 was amended to specify that this step is taken in addition to the steps taught within claim 27, i.e., “wherein step (ii) of the program includes the additional step of....” Further, also as requested by the examiner, claim 35 has been amended to clarify the meaning of “increased structural similarity,” i.e. “the engineered framework protein has increased structural similarity with said sample protein when compared to the structural similarity between said sample protein and said framework protein identified as a hit.”

Accordingly, applicants believe that the subject matter of the present invention is distinctly claimed and therefore, that this rejection should be withdrawn.

CONCLUSION

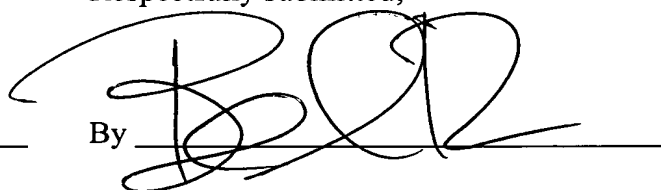
Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 17 February 2005

By

A handwritten signature in black ink, appearing to read 'B. Burrous', written over a horizontal line.

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